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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,174	09/28/1999	ANDRES SANCHEZ	P18459	2402
7055	7590	03/21/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			DEANE JR, WILLIAM J	
			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/407,174	SANCHEZ, ANDRES
	Examiner	Art Unit
	William J Deane	2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12Oct2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-24 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

In view of the Appeal Brief filed on October 12, 2004, PROSECUTION IS HEREBY REOPENED. A Non Final Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims are ambiguous. For example, it is unclear as to applicant's intent in claiming a list of telephone data, that list having both public and private data is a single list or whether applicant is claiming 2 separate lists, one being public data and the another list consisting of private data. It is also unclear as to

applicant's intent as to the phrase "public data". That is, "public data" could be data that is shared or it could be that a phone number to say, "Joe's Pizza", which is public data and could be contain in either a public list or a private list. As claimed, it is unclear as to whether each person has the same public data and whether that public data is shared or just common to multiple users. That is, each person has his own public data list, and the public data can be the same public data that other users have or each user could have different data that is public data. For example, in the list of telephone data, each user, along with his own personal data, could have a copy of the White Pages as his public data. Alternately, as claimed, the independent claims could be interpreted as each user of the telephone has different public data. For example, user 1 could have the White pages as his public data while user 2 has the Yellow pages (public data). As a further example, user 1 could, along with his personal or private data have the White Pages (public data) from state X while user 2 has White Pages (public data) from state Y. Again, it is unclear as to whether the public data is the same for all and accessible for all or whether the public data is different for each user and whether the different public data lists are accessible to the different users. Nothing in the claims indicate that the public data is shared or whether the public data is just public data inserted into a so-called "public data list".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 5, 11 – 12, 16, 18 and 23 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,195,568 (Irvin).

With respect to claims 1 – 4, 11 – 12, 16, 18 and 23 - 24 note Abstract, Col. 2, lines 3 – 67, Col. 5, lines 1 – 8, Col. 5, lines 14 – 24 and Col. 5, lines 34 – 52.

Irvin teaches the claimed method except explicitly mentioning private telephone data. However, note Col. 2, lines 44 – 67. Obviously, Irvin is concerned about privacy. In addition, note the use of multiple telephone books and operational profiles of a user. In view of the Cols. recited above, it would have been obvious to one of ordinary skill in the art to configure a user's profile to include a public telephone book and a private telephone book. Note claim 4 of Irvin, and that account information is private data. Also, note that the profiles are stored in the telephone. In addition, note display 28. Note that users' phonebooks may include public data such as the telephone numbers of the local Pizza Hut.

With respect to claim 5, such a limitation would have been obvious to one of ordinary skill in the art if not inherent in Irvin.

Claims 6 – 10, 13 –15, 17 and 19 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,259,908 (Austin).

With respect to claims 6 and 8 – 10, 14 – 15, 17, 19 – 22, note Col. 7, lines 20 – 64 of Austin. It would have been obvious to one of ordinary skill in the art to have incorporated such first and second modes of Austin into the Irvin device and method, as such would only entail replacing one well known security feature with another.

With respect to claims 7 and 13, note as claimed, the limitations of claim 7 and 13 are nothing more than the notoriously old call blocking or call screening. Such features have been in service for years (see Col. 1, lines 54 – 58 of Austin).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 6,038,551 (Barlow et al.) – note Abstract and Figs;

U.S. Patent No. 5,872,834 (Teitelbaum) – note Abstract and Figs;

U.S. Patent No. 5,842,124 (Kenagy et al.) – note Abstract and Figs.;

U.S. Patent No. 5,696,815 (Smyk) – note Abstract; and

EP 0 663 752 (Iwashita) – note Abstract.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (703) 306-5838. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 872-9306.

21Jan05


WILLIAM J. DEANE, JR.
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